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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,286	11/14/2003	Terry Daglow	1027.P0014 US	1130
29053	7590	02/24/2006	EXAMINER	
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.			SCHAETZLE, KENNEDY	
2200 ROSS AVENUE			ART UNIT	
SUITE 2800			PAPER NUMBER	
DALLAS, TX 75201-2784			3766	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/713,286	Applicant(s) DAGLOW ET AL.	
	Examiner Kennedy Schaetzle	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of claims 1, 8, 14 and 21 where a single conductive disk is electrically coupled to a plurality of lead terminals must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not appear to disclose the limitation of claims 1, 8, 14 and 21 where a plurality of terminals within an implantable lead are connected to a single conductive disk (note the term *a conductive disk* is singular).

### ***Claim Objections***

3. Claims 4 are objected to because of the following informalities: reference to "...the outer perimeter..." in claims 4 and 11 lacks antecedent basis; in claim 8, an obvious grammatical error appears on line 2; in claim 17, the phrases "...operable coupling..." and "...operable coupled..." are grammatically awkward. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants have not adequately disclosed how a single conductive disk is arranged to make contact with a plurality of terminals within a lead. The disclosure only explicitly sets forth the embodiment where one disk is connected to one terminal.

6. Claims 1-7 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble to claim 1 implies that an electrical contact alone is to be set forth, yet the body of the claim implies that the electrical contact in combination with the lead and tissue stimulation device are being set forth by reciting that the conductive disk of the electrical contact is operably coupled (the term *operably coupled* is defined by the applicant to include direct coupling as per page 12, lines 10-16) to the tissue stimulation device, and that the projections extending off the disk are electrically coupled to the lead terminals. The examiner suggests the applicants refer to such couplings in a functional sense by use of the phrase "adapted to be." In any rejection on the merits, the

examiner must assume the claim is drawn to the combination of the electrical contact with the lead and tissue stimulation device. A related comment applies to claim 21.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 14-19, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins (Pat. No. 5,730,628).

Regarding claim 1, Hawkins discloses an electrical contact comprising a conductive disk 62 having an inner aperture (see Fig. 4), wherein the conductive disk is operably coupled to the tissue stimulation device 20, and a plurality of conductive projections 68 extending away from the inner aperture of the disk, wherein the projections flex (col. 2, lines 56-65) to receive an implantable lead 22 and electrically couple to a plurality of terminals 30, 32 within the lead (see Fig. 2). The examiner considers the conductive disk to couple to a plurality of lead terminals in the same manner that the applicants consider Figs. 5A, 5C and 6 to show such an arrangement.

Hawkins clearly and explicitly discloses the limitations of claims 2, 3 and 5 (as well as additional similarly worded claims).

Regarding claim 4, the examiner considers elements 44 and 54 to represent a plurality of projections at the outer perimeter of the conductive disk which serve to couple the disk to the housing of the tissue stimulator.

Regarding claim 6, the examiner considers it inherent that the standard bipolar lead shown in Fig. 1 has a plurality of electrodes (one for each contact 30, 32) and a plurality of corresponding conductors to enable the stimulator to apply pulses to the electrodes located at the distal end of the lead. The lead, in fact, would be inoperable unless such arrangements were present.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-13, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins.

Regarding claim 7 and claims with similar limitations, although Hawkins does not disclose details associated with the tissue stimulation device and concomitantly does not discuss the use of a receiver to deliver electrical stimulation signals to the lead in response to a control signal, those of ordinary skill in the art would have considered the use of such a receiver to be blatantly obvious and completely standard in the pacer art. The examiner takes Official Notice that an implantable receiver such as set forth is conventional and well-known by ordinarily skilled tissue stimulator design artisans.

The rejection of claim 8 parallels that given above for substantially similar claim language.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

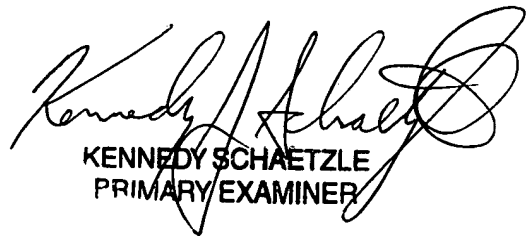
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 571 272-4954. The examiner can normally be reached on M-W and F from 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on M-F at 571 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3766

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS  
February 17, 2006



KENNEDY SCHAEETZLE  
PRIMARY EXAMINER